

Attorney Docket No. ZawadzkiA_P_1_03

Application No. 10/720,497

REMARKS/ARGUMENTS

In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

Claims 1, 11, and 20 are amended to add the phrase "reciprocating or non-reciprocating" to more closely reflect the teachings of the specification the "cutting means". This phrase, in the opinion of the Applicant, neither narrows nor broadens the claims as these limitations are contained in the description (see [0011]. In particular, the invention is a coping jig for use in woodworking. The jig comprises a template for guiding the cutting tool of a jig saw, hole saw, or router; see also [0012], [0016], and [0034]) and in the dependent claims, and as this amendment is neither narrowing nor broadening, this amendment does not necessitate further searching.

It is well-known to those of ordinary skill in the art, that jig saws are inherently reciprocating and that routers are not.

2. The rejection of Claims 1, 2, 6 - 12, and 16 - 20 under 35 U.S.C. §102(b) as being anticipated by Goodwin (U.S. Patent 5,203,389) is respectfully traversed and it is respectfully submitted that Examiner has not established a *prima facie* case of anticipation.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP 2131

In regard to amended Claim 1, amended Claim 1 recites:

A jig for cutting a work piece in a configuration conforming to a predetermined shape, comprising:

- a) a base, comprising:

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- i) a first surface area defining:
 - a work area adapted to receive a work piece, and
 - an opening for receiving a reciprocating or non-reciprocating cutting means, and
 - ii) a second surface area comprising at least one template holding means adapted to receive at least one template;
- b) at least one clamping means for releasably securing said work piece on said work area;

wherein said at least one template holding means detachably attaches at least one template thereto, wherein the direction of movement of the cutting means guided by said template is transferred to the direction of movement of a cutting member of the cutting means, thereby cutting said work piece to conform to said predetermined shape.

As understood by Applicant, Goodwin teaches a wood-joint making fixture apparatus and method of use with a router. A router's cutting means, *i.e.*, "bit" is inherently non-reciprocating and cannot be reciprocating. Moreover a router's bit is cylindrical (see router bit of Goodwin indicated by reference numeral 630). The router bit required by Goodwin's device cannot have a flat, blade like structure, such as the structure of a saw blade that is used with a jig or a hole saw. Additionally, Goodwin's device does not require, nor use, a template. The direction of motion of Goodwin's cutting means is controlled by turning cranks that are connected to threaded rods that move the router against the wood, and the direction of motion of Goodwin's cutting means is limited to cutting patterns that contain only straight edges and only right angles. Goodwin's device is not structurally designed nor could it be used to cut arbitrary curves.

Conversely, Applicant's device may use, and recites in each of the independent claims a cutting means that can be either reciprocating or non-reciprocating. Moreover, the cutting means used in the device taught by Applicant may be cylindrical or flat, is controlled by a template, and can cut arbitrary curves or angled pieces, as claimed.

As a claim can be anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and

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Goodwin does not teach a cutting means that may be reciprocating or non-reciprocating. Goodwin cannot be used as a valid reference to reject Claims 1, 11, and 20.

As Claims 2, 6 – 10, and 12 – 19 depend, either directly or indirectly, from Independent Claims 1 and 11 are believed to be patentable for the same reasons.

2. The rejection of Claims 3 and 13 under 35 U.S.C. §103(a) as being unpatentable by Goodwin (U.S. Patent 5,203,389) in view of Mecsey (4,355,557) is respectfully traversed and it is respectfully submitted that Examiner has not established a *prima facie* case of obviousness.

MPEP 2143: To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. It follows then that if there is no suggestion or motivation to combine the references then a *prima facie* case of obviousness has not been established.

As discussed above, Goodwin does not teach or suggest all the claim limitations. Therefore, Applicant respectfully argues that Goodwin is an invalid reference and that Claims 3 and 13 are thus patentable.

Moreover, Applicant's claims recite that the template directs the movement of the cutting means (see last paragraph of Claims 1 and 11: "... wherein said at least one template holding means detachably attaches at least one template thereto, wherein the direction of movement of the cutting means guided by said template is transferred to the

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direction of movement of a cutting member of the cutting means, thereby cutting said work piece to conform to said predetermined shape." Claim 20 recites similarly: "wherein said at least one template holding means detachably attaches at least one template thereto, wherein the direction of movement of the cutting means guided by said template is transferred to the direction of movement of a cutting member of the cutting means, thereby cutting said work piece to conform to said predetermined shape.") Thus, Applicant both teaches in the specification and recites in the claims the fact that the template guides the cutting means. Applicant does not teach, require, or depend on the use of a follower.

In contrast, Mecsey's device requires a follower (in all three embodiments). The follower is directed by the template and in turn guides the cutting means. Applicant's device is simpler in that Applicant's invention eliminates the need for a follower, making Applicant's device simpler to use and simpler to make, thus making the device more affordable for all.

It would not be obvious to combine Mecsey's device with that of Goodwin to make the present invention because Goodwin does not use templates or followers, the movement of Goodwin's is controlled by turning cranks that are connected to threaded rods that move the router against the wood. The two devices have incompatible structures and combining them would make a device that did not work,

3. The rejection of Claims 4, 5, 14, and 15 under 35 U.S.C. §103(a) as being unpatentable by Goodwin (U.S. Patent 5,203,389) in view of Despres (5,096,341) and Wilhelm *et al.* (3,186,726) is respectfully traversed and it is respectfully submitted that Examiner has not established a *prima facie* case of obviousness.

As discussed above, Goodwin does not teach or suggest all the claim limitations. Therefore, Applicant respectfully argues that Goodwin is an invalid reference and that Claims 4, 5, 14, and 15 are thus patentable.

Examiner states that Goodwin is lacking in that Goodwin does not disclose a jig saw nor a hole saw, but that Despres teaches a hole saw and Wilhelm teaches a jig saw. As

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discussed in some detail above, Goodwin could not have taught a jig saw or a hole saw as these are reciprocating cutting means and Goodwin's router uses non-reciprocating cutting. Thus, there would be no reason for anyone to combine these references.

Moreover, the device taught by Wilhelm is a saber saw that has a flat blade but that can cut in one direction only. Depres drills only a hole which is used as a guide hole, whereas Applicant's cutting means cuts (saws) a radius in a piece of molding to match the radius of a previously shaped piece of molding using a guide hole that is built-in the bushing of Applicant's invention. These devices are all different from one another and are all made for different purposes. There was, and still is, no reason for anyone to attempt to combine the teachings of these patents in any way that could bring about Applicant's invention because that is an impossibility.

4. The prior art made of record and not relied on is as cited and has been considered.

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CONCLUSION

In view of the above amendments and related arguments, the application is now believed to be in condition for allowance. Accordingly, favorable reconsideration and early passage to issue of the present Application are most respectfully requested.

Respectfully submitted,

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